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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,432	10/02/2000	James B. McCarthy	110.01130101	3387

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EXAMINER

LUKTON, DAVID

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 05/08/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/600,432

Applicant(s)

MCCARTHY ET AL.

Examiner

David Lukton

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-11 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) 23-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18. 6) ☐ Other:

Pursuant to the directives of paper No. 17 (filed 3/11/03), claims 1-5 12-22 have been cancelled, claims 6, 7, 23 amended, and claims 24-28 added. Claims 6-11, 23-28 are pending. Claims 23-28 are withdrawn from consideration. Claims 6-11 are examined in this Office action.

Applicants' arguments filed 3/11/03 have been considered and found persuasive. The previously imposed rejections are withdrawn.

*

Claims 7-11 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is indefinite as to whether the "modulating" ever occurs. The same issue applies in the case of claims 8-11.

*

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the

United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2) and (4) of section 371(c) of this title before the invention thereof by the applicant for the patent.

Claims 6-11 are rejected under 35 U.S.C. §102(b) as being anticipated by Newsholme (*Journal of Biological Chemistry* **267**(2), 810-18, 1992).

Newsholme discloses (table 1, page 811) several peptide sequences. The peptide which is fourth from last begins with the following sequence:

LRRLIDAYA**ARIYGH**

This sequence contains the sequence **A-R-I-Y**.

Claim 6 is anticipated because the term "having", when applied to a peptide sequence, is interpreted to mean that any number of amino acids can be added to either end of the indicated sequence. Thus, a peptide of 20 amino acids, or 200 amino acids, would be included, as long as it contains the sequence ARIY or RIY. The remaining claims are anticipated because the recited properties are inherent in the prior art peptide.

✱

Claims 6-11 are rejected under 35 U.S.C. §102(b) as being anticipated by Ohba (USP 5,359,048).

Ohba discloses a peptide which spans cols 17-26. In col 19, amino acid residues 291 -

294 are disclosed. The tetrapeptide sequence disclose therein is the following:

Ala-Arg-Ile-Tyr

Claim 6 is anticipated because of the presence of the term "having". The remaining claims are anticipated because the recited properties are inherent in the prior art peptide. It is suggested that claim 6 be amended to convey that the claimed peptides only "consist" of the indicated sequences.

※

Claims 6-11 are rejected under 35 U.S.C. §102(b) as being anticipated by Westerlink (*Proc Natl Acad Sci* **92**, 4-21, 1995)

Westerlink discloses (table 1, page 4023) a peptide which begins with the following sequence:

CARIYY

Claim 6 is anticipated because of the presence of the term "having". The remaining claims are anticipated because the recited properties are inherent in the prior art peptide.

※

- JP 6016568 was stricken from the IDS because of the absence of a translation. It is suggested that the following be listed under the "other documents" section:

English Abstract of JP 6016568

- Seki ("Quantitative analysis of digestion-resistant ACE inhibitor dipeptides...")

was stricken from the IDS because of the absence of a translation. It is suggested that the following be listed under the "other documents" section:

English Abstract of Seki (*J. Jap. Soc. Food Sci. Technol.* 43, 967, 1996)

- The remaining references were stricken from the IDS because they were not received.

— An Abstract is required —

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


DAVID LUKTON
PATENT EXAMINER
GROUP 1800